



27 NOV 2002

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In re Application of
FALLS, Douglas, S., et al.
U.S. Application No.: 08/983,394
PCT No.: PCT/US96/12575
International Filing Date: 31 July 1996
Priority Date: 31 July 1995
Attorney's Docket No.: 5071/00001
For: ELECTRONIC PRODUCT INFORMATION
DISPLAY SYSTEM

DECISION ON PETITION TO
REVIVE ABANDONED
APPLICATION UNDER 37
CFR 1.137(b)

This decision is issued in response to applicants' "Petition For Revival Of An Unintentionally Abandoned Patent Application Under 37 CFR 1.137(b)" filed on 05 August 2002. Applicants paid the \$640 small entity petition fee. Because the large entity fee is required, Deposit Account No. 50-0311 will be charged an additional \$640 to bring applicants' payment to the required \$1,280.

BACKGROUND

On 31 July 1996, applicants filed international application PCT/US96/12575 which claimed a priority date of 31 July 1995 and which designated the United States.

On 26 February 1997, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 31 January 1998.

On 20 January 1998, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 25 August 1998, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 28 September 1998, applicants filed a response to the Notification Of Missing Requirements which included payment of the required surcharge and an executed declaration.

On 05 January 1999, the DO/EO/US mailed a Notification Of A Defective Oath Or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed on 28 September 1998 was defective. Specifically, the declaration was defective for failure to include the name and signature of the fourth named inventor A. Scott McPhillips.

On 14 January 2000, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a timely response to the Form PCT/DO/EO/917 mailed 05 January 1999.

On 05 August 2002, applicants filed the "Petition For Revival Of An Unintentionally Abandoned Patent Application Under 37 CFR 1.137(b)" considered herein.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, the "required reply" was a proper response to the Notification Of A Defective Oath Or Declaration, i.e., a properly executed declaration in compliance with 37 CFR 1.497. Applicants here have attached to the petition a copy of a three page declaration executed by all four inventors. However, a review of this declaration reveals that it still is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The three page document consists of one copy of a page identified as "Page 1 of 2" and two different copies of pages identified as "Page 2 of 2." The pages identified as "Page 2 of 2" are not identical. One version of page 2 identifies three of the four inventors, and is executed by these three; the second version of page 2 identifies only the fourth inventor, A. Scott McPhillips, and is executed by him. Because the pages are all identified as being part of a two page declaration, it is not clear whether the inventors were presented with the full three page document submitted here (i.e., one document with both versions of page 2 included) or whether two separate two page declarations (neither of which identified all the inventors) have been compiled into a single document. Such compilation is impermissible (see MPEP § 201.03, page 200-7). Based on the above, applicants have not yet submitted the "required reply." Item (1) is therefore not satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). The Petition For Revival was accompanied by a check in the amount of \$640 for the small entity petition fee. Because the large entity fee is required here, Deposit Account No. 50-0311 will be charged an additional \$640 to bring applicants' payment to the required \$1,280. Based on this charge, item (2) is satisfied.

As for item (3), the Petition For Revival states that the "entire delay in filing the required reply from the due date until the filing of the present petition was unintentional," and the facts regarding the abandonment are discussed in the petition itself and the accompanying declaration of Ernest J. Dale. However, these statements are not provided by the persons who controlled the prosecution of this application at the time of its abandonment. The facts submitted refer to the bankruptcy of Intelledge, the company that controlled the prosecution of this application, and the purchase of the rights to the application by Information Planning And Management Service, Inc. ("IPMS") in July 1999. The petition also mistakenly implies that January 2000, the date the Notice Of Abandonment was mailed, is the date of abandonment. In fact, the application became abandoned at midnight on 05 February 1999, the date on which a response to the Notification Of A Defective Response was due. The abandonment therefore occurred at the time when Intelledge and its appointed agents (Charles A. Laff, et al.) were controlling the prosecution of the application. Further statements must be provided by persons who controlled this prosecution at the time of abandonment before a determination can be made as to whether a decision was made to intentionally abandon the application. Accordingly, item (3) has not been satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application.

Because applicants have not satisfied all the requirements for a grantable petition under 37 CFR 1.137(b), the Petition For Revival cannot be granted on the present record.

CONCLUSION

Applicants Petition For Revival is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)" and should include an acceptable declaration in compliance with 37 CFR 1.497 and a statement from persons who controlled the prosecution of this application at the time of abandonment as to whether the application was intentionally allowed to become abandoned. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office

A handwritten signature in black ink, appearing to read 'RMR' followed by a stylized flourish.

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